Remarks

I. Status of the Application

Claims 1, 4-12, and 30-34 were pending. Claims 1, 4-12, and 30-34 have been rejected by a final Office Action mailed September 19, 2008 (the "Office Action"). Claims 1 and 4 have been amended. These amendments do not add new matter. The amendments are supported by the originally filed specification and claims, including published paragraph [0009], [0011], [0015], [0031], and [0033]. In accordance with the Request for Continued Examination (RCE), Applicants respectfully request entry of the amendments and remarks made herein.

II. 35 U.S.C. § 103 Rejections

For the reasons detailed below, all pending claims are not rendered obvious by any single reference or combination of references cited by the Office. Three criteria must be present to establish a prima facie case of obviousness. MPEP §2143. First, the prior art reference(s) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation in the knowledge generally available to one of ordinary skill in the art to modify or combine the reference(s). Third, there must be a reasonable expectation of success. *Id.* Here, it will be plainly shown that not one of these criteria is met for the Office Action's current rejections under § 103.

A. Claims 1, 4-12, and 30-34

Reconsideration is requested of the rejection of claims 1, 4-12, and 30-34 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,112,191 ("Burke") in view of U.S. Patent No. 6,164,533 ("Barton").

The Office Action asserts that "regarding claims 1 and 30, Burke discloses a method for effectuating an investment including completing a point-of-sale transaction by a user at a point-of-sale location using an electronic payment method (check, credit, debit cards) associated with a purchasing or savings account, receiving by a computer a request to complete an on-demand investment transaction after completion of the point of sale transaction . . ." The Action further asserts, ". . . it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to include the investment-preference information a predetermined monetary investment amount for the on-demand investment, in accordance with the teachings of Barton."

However, the Office Action states that Burke "**does not** specifically **teach that the investment preference information** includes any predetermined monetary investment amount . . . as the investment amount in the method of Burke is specified at the point-of-sale location at the time of the sale." See page 3, lines 3-5. Therefore, Burke does not teach "identifying, by the computer, investment-preference information associated with the user in response to receiving the request" as currently recited by claim 1. To render a claim obvious under § 103, a prior art reference or combination of references must teach or suggest each and every recited element. **Here, the Office has admitted that Burke cannot teach "the investment preference information" as recited in claim 1**.

Moreover, this failure cannot be cured by the Office's assertion to combine Burke and Barton. As shown in the declaration of record submitted by Applicants on July 10, 2008, **one of skill in the art would have been incapable of combining the teachings of Burke and Barton** because the two systems are incompatible and would produce an inoperative device.

Specifically, the above-referenced declaration provides that the Burke patent "interferes with the underlying purchase transaction between the consumer and merchant" and requires "overpayment by the consumer for the merchant's goods or services" (See Declaration filed July 10, 2008, at page 1, paragraph 7). Because one of skill in the art would know the critical failures of Burke, there was absolutely **no motivation to combine** and **no reasonable expectation of success** at the time of filing as required by § 103. "If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness." *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001). As such, the Office has failed to make a prima *facie case* of obviousness under § 103. In view of the declaration of record, the Applicants have also shown that Burke and Barton **teach away** from one another with regard to the currently claimed invention and cannot be rationally combined for the purposes of § 103.

The MPEP states that: "impermissible hindsight must be avoided and the legal conclusion [of obviousness] must be reached on the basis of facts gleaned from the prior art." MPEP § 2142. Here, among other key failures, Burke fails to teach an investment transaction and point-of-sale transaction as two separate transactions, as currently claimed by Applicants. In all of Burke's teachings, an "excess amount" is added to the "transaction amount" to create a "total withdrawal." Burke clearly indicates the "total withdrawal" in all embodiments of the patent disclosure, and does not allow for two separate transactions or at different points in time. The One of skill in the art would appreciate that **modification of Burke would fail to provide an operative device or any authorized transaction**. Accordingly, the teachings of Burke are

inoperable without the "total withdrawal" and the total withdrawal method **teaches away** from the currently claimed invention.

In addition to the above arguments, the Office Action has failed to identify where in the prior art the following element of claim 1 is taught or suggested:

> "wherein the **investment-preference information includes the user's purchasing or savings account linked to an investment account, and a predetermined monetary investment amount determined prior to start of the point-of-sale transaction for the on-demand investment.**"

In particular, the Action fails to identify any **link** whatsoever between a purchasing or savings account and an investment account **prior** to the start of the point-of-sale transaction for the on-demand investment. Thus, the Office has failed to make a prima *facie case* of obviousness under § 103 regarding claim 1. The above arguments regarding claim 1 are hereby reasserted with regard to all of its dependent claims.

Additionally, independent claim 30 requires, in part, "completing a first, point-of-sale transaction by a user "at a point of sale location;" and "**receiving, by a computer, a request to conduct a second, separate, on-demand investment transaction after completion of the first, point-of-sale transaction.**" The element reciting a "**second, separate, on demand investment transaction**" has not been identified by the Office Action and, consequently, a *prima facie* case of obviousness has not been established regarding claim 30 or its dependent claims. After all, the MPEP requires that: "the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination

and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (See, *e.g.*, MPEP § 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Independent claims 1 and 30 also embody one or more significant features that support a finding of non-obviousness and which the Office Action has failed to consider, including the following:

1. The Applicants' currently claimed invention does not interrupt the point-of-sale transaction thereby preserving a timely transaction;
2. The Applicants' currently claimed invention does not modify the transaction amount, thereby reducing the risk of going overlimit that Burke's "total withdrawal" concept specifies;
3. The Applicants' currently claimed invention automatically generates a separate transaction that is authorized and accounted for separately to;
4. The Applicants' currently claimed invention uses a constant monetary amount to reduce the investment amount variability that a per-cent or point-of-sale specified amount triggers;
5. The Applicants' currently claimed invention allows one an investment amount to be made from a source of savings other than the payment method; and
6. The Applicants' currently claimed invention allows the investment transaction to be cancelled without affecting the point-of-sale transaction.

It is respectfully asserted that the above-identified rebuttal evidence has not been properly considered by the Office.

For the reasons set forth above, independent claims 1 and 30 and the claims dependent upon them would not, therefore, have been obvious in light of the cited art. In particular, it has been shown that (1) **not all elements have been suggested or taught by the cited combination**, (2) there would have been **no motivation to combine the references as cited by the Office (*e.g.*, an inoperative device)**, and (3) there would have been **no reasonable expectation of success**. The above-arguments regarding claims 1 and 30 are hereby reasserted with regard to all of their respective dependent claims. Withdrawal of the rejection and reconsideration of the claims is respectfully requested.

B. Claims 1 and 4

Claims 1 and 4 are currently amended to respectively recite "a distinct on-demand investment transaction after completion of the point-of-sale transaction" and "accumulating a plurality of distinct on-demand investment requests from the use of the electronic payment method to complete on-demand investment transactions until a predetermined completion time." Nowhere has the Office identified the "distinct on-demand investments" as presently claimed by Applicants.

Furthermore, claim 4, which is dependent on claim 1, refers specifically to accumulating electronic investment requests prior to authorization not cash deposits of investment transactions after authorization. The Office Action's comments concerning claim 4 were as follows, "Regarding claim 4, the method of Burke further comprises the step of temporarily accumulating the on-demand investment request until a predetermined completion time. See, in particular, column 3, lines 4-13." However, **the portion of Burke cited by the Office does not teach the accumulation of investment requests**. Instead, Burke accumulates **deposits of completed**

investment transactions – **not investment requests prior to authorization**. Burke specifically states that the payment, including excess funds, has already been rendered at the point of sale:

> " . . . the excess funds are created at point of sale counters (POS) by the **merchant/collectors (MC) who "front end" process the subscriber/payor (SP) spending transactions** to determine the excess difference between the purchase price of goods or services and the amount of payment rendered" (See Burke, col. 2, lines 55-59).

In view of the above remarks and the amendments to claims 1 and 4, the Applicants respectfully request that the obviousness rejections under § 103 have been traversed and reconsideration is respectfully requested.

C. Claims 9-11

The Office Action has failed to identify where in the prior art the following element of claim 9 is taught or suggested:

> "prompting a user at a point-of-sale location, to request that an on-demand investment transaction be performed, **after completion of a point of sale transaction**"

In particular, the Action fails to identify a reference that prompts a user as claimed **after completion of a point of sale transaction**. Thus, the Office has failed to make a prima *facie case* of obviousness under § 103 regarding claim 9 and related dependent claims 10-11. By way of example, Burke Column 12 lines 1-16 states:

> "Under this system, the SP opens up a new account or updates an existing account, e.g. checking, credit, or debit account, and instructs the bank or credit card issuer to add or subtract a

> determinant to each transaction after they are returned to the bank or credit issuer for final debiting against the consumer's account."

By contrast, however, the currently claimed invention removes the requirement to use the same account as the one used for the purchase and clearly provides for independence between the payment method and the source of the investment amount. In view of the above remarks, the Applicants respectfully request that the obviousness rejections under § 103 have been traversed and reconsideration is respectfully requested.

D. Claims 5-8, 12, 31-32, 33-34

Claims 5-8, 12, and 33-34 are all dependent on claim 1, whereas claims 31-32 are dependent on claim 30. The above arguments from parts A and B regarding independent claims 1 and 30 are hereby incorporated and reasserted with respect to all dependent claims, particularly including 5-8, 12, 31-32, and 33-34. In view of this, the Applicants respectfully request that all obviousness rejections under § 103 have been traversed and reconsideration is respectfully requested.

III. Conclusion

Applicants respectfully submit that the instant application is in good and proper order for allowance and early notification to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the instant application, the Examiner is encouraged to call the undersigned at the number listed below.

Respectfully submitted,
POLSINELLI SHUGHART PC

Dated: March 19, 2009

On behalf of: Patrick Woolley
Registration No.: 39,078

By: /J. Morgan Kirley/
J. Morgan Kirley
Registration No.: 59,089
Customer No.: 27148

POLSINELLI SHALTON FLANIGAN SUELTHAUS PC
700 W 47th St Ste 1000
Kansas City, MO 64112
816-753-1000 (main)
816-360-4280 (direct)
816-753-1536 (fax)
pwoolley@polsinelli.com